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09/586,410	06/01/2000	Mark Clark	00 P 7661 US	6338

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Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
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EXAMINER

NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,410

Applicant(s)

CLARK ET AL.

Examiner

Qamrun Nahar

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,13-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,13-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the RCE filed on 07/06/2006.
2. Claims 1, 6, 11 and 16 have been amended.
3. Claims 1, 3-6, 8-11, 13-16 and 18 are pending.

Response to Amendment

Claim Objections

4. Claim 6 is objected to because of the following informalities: it is missing an ending period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3-6, 8-11, 13-16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 6, 11 and 16 have been amended to recite “wherein said source file with extended grammar constructs is associated with existing executables”, which was not described in the specification. Therefore, this amended limitation is new matter. This limitation is

Art Unit: 2191

interpreted as “wherein said source file with extended grammar constructs is associated with executables”.

Claims 3-5, 8-10, 13-15 and 18 are rejected for dependency upon rejected base claims 1, 6, 11 and 16, respectively, above.

7. Claims 1, 3-6, 8-11, 13-16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 6, 11 and 16 have been amended to recite “wherein said source file with extended grammar constructs is associated with existing executables”, which was not described in the specification. One skilled in the art to which it pertains, or with which it is most nearly connected, would not be enabled to make and/or use the invention. This limitation is interpreted as “wherein said source file with extended grammar constructs is associated with executables”.

Claims 3-5, 8-10, 13-15 and 18 are rejected for dependency upon rejected base claims 1, 6, 11 and 16, respectively, above.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 3-6, 8-11, 13-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1, 6, 11 and 16 have been amended to recite “wherein said source file with extended grammar constructs is associated with existing executables”, which renders the claims indefinite because there is no support in the specification. Therefore, this limitation is interpreted as “wherein said source file with extended grammar constructs is associated with executables”.

Claims 3-5, 8-10, 13-15 and 18 are rejected for dependency upon rejected base claims 1, 6, 11 and 16, respectively, above.

11. Regarding claim 18, the parenthesis on line 4 of the claim renders the claim indefinite because it is unclear whether the limitation “where x is greater than or equal to 1” inside the parenthesis is part of the claimed invention.

12. Claim 18 recites the limitation “where x is greater than or equal to 1” on line 4 of the claim which renders the claim indefinite because it is unduly broader than the disclosure. The specification only provides support for where x is 1, 2 or 3. It is suggested that the limitation be amended to recite similar limitation as in claim 4.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2191

14. Claims 1, 3-5, 16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. Claim 1 appears to be a system of software alone, lacking the necessary physical components (hardware) to constitute a machine or a manufacture under 101. Since claim 1 is clearly not a process or a composition of matter, it appears to fail to fall within a statutory category and thus non-statutory.

Claims 3-5 are rejected for failing to cure the deficiencies of the above rejected non-statutory claim 1.

16. As per claim 16, merely claimed as a program representing a computer listing *per se* (computer-readable computer program product), that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. Such claimed programs do not define any structural and functional interrelationships between the program and other claimed aspects of the invention which permit the program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable **medium** needed to realize the program’s functionality. In contrast, a claimed computer-readable **medium** encoded with a program defines structural and functional interrelationships between the program and the medium which permit the program’s functionality to be realized, and is thus

Art Unit: 2191

statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

Claim 18 is rejected for failing to cure the deficiencies of the above rejected non-statutory claim 16.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1, 6, 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583), and further in view of Li (U.S. 6,063,133).

Per Claim 1 (Amended):

Chang teaches a system ("system" in column 2, lines 46-47 and Fig. 1), comprising: a translator adapted to translate between extended grammar constructs of a machine readable language and basic grammar constructs of said machine readable language ("pre-compiler" in column 2, lines 53-68 to column 3, lines 1-6, pre-compiler is interpreted as a translator; supplemental language is interpreted as extended grammar constructs; and host language is interpreted as basic grammar constructs), wherein a translation comprises reading a source file containing extended grammar constructs, performing a lookup table conversion of said source

Art Unit: 2191

file of extended grammar constructs into a basic source file containing only basic grammar constructs, said translator configured to implement one or more configurable levels of precompilation (column 3, lines 1-6; column 4, lines 55-68 to column 5, lines 1-21; and see Fig. 2; Multiple configurable levels of precompilation are shown in Figure 2, i.e., “Declaration Mode” is one level, and “SQL Statement” is another level.); and a compiler coupled to receive an output of said translator for compiling code written in said basic grammar constructs, wherein said compiler generates executable code implementing a function of the extended grammar constructs as compiled basic grammar constructs (“The modified source file 22 can then be compiled by a host language compiler 24” in column 3, lines 13-16); wherein said source file with extended grammar constructs is associated with executables (“procedure calls” in column 3, lines 1-6).

Chang does not explicitly teach that the machine readable language being ASN.1 or wherein said translation comprises a direct conversion from said source file to said basic source file. Bapat teaches that the machine readable language being ASN.1 (column 3, lines 10-16 and see Fig. 20, item 14 “ASN.1 SOURCE FILES WITH OBJECT CLASS DEFINITIONS”; ASN.1 source files contain ASN.1 grammar constructs, which is compiled into machine readable language). Li teaches wherein said translation comprises a direct conversion from said source file to said basic source file (column 3, lines 30-38).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by Chang to include the machine readable language being ASN.1 and wherein said translation comprises a direct conversion from said source file to said basic source file using the teaching of Bapat and Li. The modification

Art Unit: 2191

would be obvious because one of ordinary skill in the art would be motivated to use standardized data structure protocol (Bapat, column 1, lines 27-38) and to parse source code without generating an intermediate file (Li, column 3, lines 20-23).

Per Claim 6 (Amended):

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “a first source file” (Chang, column 2, lines 59-60), “a second source file” (Chang, column 3, lines 3-6), and “multiple configurable levels of precompilation” (see Fig. 2; Multiple configurable levels of precompilation are shown in Figure 2, i.e., “Declaration Mode” is one level, and “SQL Statement” is another level.). Thus, accordingly, this claim is also obvious.

Per Claim 11 (Amended):

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “multiple configurable levels of precompilation” (see Fig. 2; Multiple configurable levels of precompilation are shown in Figure 2, i.e., “Declaration Mode” is one level, and “SQL Statement” is another level.). Thus, accordingly, this claim is also obvious.

Per Claim 16 (Amended):

This is a computer-readable computer program product version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered

Art Unit: 2191

in cited areas as set forth above, including “wherein said computer-readable program code is adapted to directly translate said extended grammar constructs into said basic grammar constructs by using one or more lookup tables” (Li, column 3, lines 30-38), and “multiple configurable levels of precompilation” (see Fig. 2; Multiple configurable levels of precompilation are shown in Figure 2, i.e., “Declaration Mode” is one level, and “SQL Statement” is another level.). Thus, accordingly, this claim is also obvious.

19. Claims 3-5, 8-10, 13-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583), further in view of Li (U.S. 6,063,133), and further in view of Applicant Admitted Prior Art (hereinafter AAPA).

Per Claim 3:

The rejection of claim 1 is incorporated, and further, neither Chang, Bapat nor Li explicitly teaches that the basic grammar constructs comprises X.680 grammar constructs. AAPA teaches that the basic grammar constructs comprises X.680 grammar constructs (pg. 1, line 32).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by the combination of Chang, Bapat and Li to include the basic grammar constructs comprising X.680 grammar constructs using the teaching of AAPA. The modification would be obvious because one of ordinary skill in the art would be motivated to use a common basic compiler.

Art Unit: 2191

Per Claim 4:

The rejection of claim 3 is incorporated, and further, neither Chang, Bapat nor Li explicitly teaches that the extended grammar constructs comprises at least one of X.681, X.682, or X.683 grammar constructs. AAPA teaches that the extended grammar constructs comprises at least one of X.681, X.682, or X.683 grammar constructs (pg. 1, lines 27-31).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by the combination of Chang, Bapat and Li to include the extended grammar constructs comprising at least one of X.681, X.682, or X.683 grammar constructs using the teaching of AAPA. The modification would be obvious because one of ordinary skill in the art would be motivated to develop applications using other grammar constructs.

Per Claim 5:

The rejection of claim 4 is incorporated, and Chang further teaches that the translator comprising one or more lookup tables (column 3, lines 1-6 and Fig. 1, item 36).

Per Claim 8:

This is a method version of the claimed system discussed above, claim 4, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Per Claim 9:

Art Unit: 2191

This is a method version of the claimed system discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also obvious.

Per Claim 10:

This is a method version of the claimed system discussed above, claim 5, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “equivalent constructs” (Chang, column 3, lines 1-6). Thus, accordingly, this claim is also obvious.

Per Claims 13-15:

These are method versions of the claimed system discussed above (claims 3, 4, and 5, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

Per Claim 18:

This is a computer-readable computer program product version of the claimed system discussed above (claims 3 and 4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Response to Arguments

20. Applicant's arguments with respect to claims 1, 3-6, 8-11, 13-16 and 18 have been considered but are moot in view of the new ground(s) of rejection.

In the remarks, the applicant argues that:

a) Chang fails to teach “wherein said source file with extended grammar constructs is associated with existing executables”.

Examiner's response:

a) See the rejection under 35 U.S.C. 112, first and second paragraph, for this limitation in paragraphs 6, 7 and 10 above.

In the remarks, the applicant argues that:

b) Like Chang, Bapat appears to have nothing to do with translating extended grammar constructs into basic grammar constructs, “multiple configurable levels of precompilation”, or “wherein said compiler generates executable code implementing a function of the extended grammar constructs as compiled basic grammar constructs” or “wherein said translation comprises a direct conversion from said source file to said basic source file” or “wherein said source file with extended grammar constructs is associated with existing executables” as generally recited in the claims at issue.

Examiner's response:

Art Unit: 2191

b) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Chang is relied upon for these limitations, not Bapat.

In the remarks, the applicant argues that:

c) Li is relied on for allegedly teaching a “direct conversion”. However, like Chang and Bapat, Li does not appear to relate, inter alia, to “wherein said source file with extended grammar constructs is associated with existing executables” as generally recited in the claims at issue.

Examiner's response:

c) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Chang is relied upon for this limitation, not Bapat or Li.

In the remarks, the applicant argues that:

Art Unit: 2191

d) APAA fails to relate in any way to a translator as recited in the claims at issue (indeed, that is a very object of the present invention), its combination with Chang, Li, and Bapat likewise fails to teach, suggest or imply the present invention.

Examiner's response:

d) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Chang is relied upon for a translator, not Bapat or Li or APAA.

Conclusion

21. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y Zhen, can be reached on (571) 272-3708. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 2191

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Qamrun Nahar
August 8, 2006



WEI ZHEN
SUPERVISORY PATENT EXAMINER